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Barnes & Thornburg
11 South Meridian Street
Indianapolis, IN 46204

EXAMINER	
FONTAINE, MONICA A	
ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,787	WILLIAMSON ET AL.	
	Examiner	Art Unit	
	Monica A Fontaine	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *111201*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosas et al. (U.S. Patent 5,975,116). Regarding Claim 13, Rosas et al., hereafter "Rosas," shows that it is known to have a vent apparatus adapted to be coupled to a vehicle fuel tank, the apparatus comprising a valve housing made from a non-weldable plastics material and formed to include a cylindrical sleeve defining an interior region, a top wall coupled to the cylindrical sleeve and formed to include an aperture and an annular flange defining an annular channel, and a venting outlet coupled to the top wall at the aperture and provided to conduct fuel and fuel vapor from the interior region of the cylindrical sleeve to another destination outside the valve housing (Figure 3, elements 16, 24, 30), a valve positioned to lie within the interior region of the cylindrical sleeve and formed to move within the interior region of the cylindrical sleeve to open and close the aperture defined by the top wall of the valve housing which leads to the venting outlet (Figure 3, element 16), and a tank mount made from a weldable plastics material, coupled to the top wall of the valve housing, and formed to include an outer rim adapted to be coupled to the fuel tank to support the cylindrical sleeve within the tank, an annular rib formed to be

received within the annular channel of the flange of the top wall, and a top wall coupled to and positioned to lie between the outer rim and the annular rib, the tank mount being positioned to cause the top wall of the tank mount and the top wall of the valve housing to lie in coplanar relation with one another (Figure 3, elements 18, 32, 42; Column 3, lines 1-10, 21-27, 34-39).

Regarding Claim 14, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 13 above, including an apparatus wherein the tank mount is ring-shaped and is further formed to include an annular interior wall defining an opening formed to receive the top wall of the valve housing, and the annular inner rib of the tank mount is coupled to the annular interior wall and is formed to extend into the opening (Figures 1 and 3).

Regarding Claim 15, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 13 and 14 above, including an apparatus wherein the interior wall of the tank mount includes an upper face and a lower face and the annular inner rib is positioned to lie midway between the upper face and the lower face (Figure 3, element 18).

Regarding Claim 16, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 13 and 14 above, including an apparatus wherein the top wall of the tank mount is positioned to extend radially outwardly from the interior wall and the outer rim of the tank mount is coupled to the top wall of the tank mount, formed to extend radially downwardly from the top wall of the tank mount, and formed to include a bottom face adapted to be coupled to the fuel tank (Figure 2, elements 14 and 18).

Regarding Claim 17, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 13 and 14 above, including an apparatus wherein the inner rib is formed to define a notch and the flange of the valve housing is formed to include a locator tab to be received within

the notch in order to prevent rotation between the tank mount and the valve housing (Figure 3, elements 16 and 18).

Regarding Claim 18, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 13 above, including an apparatus wherein the venting outlet of the valve housing is positioned to lie above the tank mount and the cylindrical sleeve of the valve housing is positioned to lie below the tank mount (Figure 2, elements 16, 18, 30).

Regarding Claim 19, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 13 above, including an apparatus wherein the top wall of the tank mount further includes a top surface and a bottom surface and the outer rim of the tank mount includes an outer surface and an inner surface, and wherein the top surface of the top wall has a length, X, and the outer surface of the outer rim has a height, Y, and further wherein X is greater than Y (Figures 2 and 3).

Regarding Claim 20, Rosas shows that it is known to have a vent apparatus adapted to be coupled to a fuel tank, the apparatus comprising a valve housing formed to include a cylindrical sleeve defining an interior region, a top wall coupled to the cylindrical sleeve and formed to include an aperture and an annular flange defining an annular channel, and a venting outlet coupled to the top wall at the aperture in order to conduct fuel and fuel vapor from the interior region of the cylindrical sleeve to another destination outside the valve housing (Figure 3, elements 16, 24, 30), a valve positioned to lie within the interior region of the cylindrical sleeve and formed to move within the interior region of the cylindrical sleeve to open and close the aperture defined by the top wall of the valve housing (Figure 3, element 16, 30), and a tank mount coupled to the top wall of the valve housing and formed to include an outer rim adapted to

be coupled to the fuel tank to support the cylindrical sleeve within a mounting aperture of the tank and an annular rib formed to be received within the annular channel of the flange, and wherein the valve housing is includes a locator tab coupled to the annular flange and the annular rib includes a notch formed to receive the locator tab of the valve housing in order to prevent rotation between the valve housing and the tank mount (Figure 3, elements 18, 32, 42).

Regarding Claim 21, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 20 above, including an apparatus wherein the tank mount includes a top wall and the venting outlet of the valve housing is positioned to lie above the top wall of the tank mount and the cylindrical sleeve of the valve housing is positioned to lie below the top wall of the tank mount (Figure 2, elements 16, 18, 30).

Regarding Claim 22, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 20 and 21 above, including an apparatus wherein the tank mount further includes an interior wall defining an opening for receiving the top wall of the valve housing therein and the inner rib of the tank mount is coupled to the interior wall and positioned to extend into the opening of the tank mount, and wherein the tank mount further includes a top wall positioned to extend radially outwardly from the interior wall, and the outer rim is coupled to the top wall and is positioned to extend radially downwardly from the top wall (Figure 2, elements 14, 16, 18; Figure 3, elements 16, 18).

Regarding Claim 23, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 20 and 21 above, including an apparatus wherein the valve housing is made from a non-weldable plastics material and the tank mount is made from a weldable plastics material and the inner lib of the tank mount is received within the channel of the flange of the top wall of the

valve housing to cause the tank mount to be mechanically coupled to the valve housing (Figure 3, elements 16, 18; Column 3, lines 1-10).

Regarding Claim 24, Rosas shows that it is known to have a vent apparatus adapted to be coupled to a fuel tank, the apparatus comprising a valve housing made from a non-weldable plastics material and formed to include a cylindrical sleeve defining an interior region, a top wall coupled to the cylindrical sleeve and formed to include an aperture and an annular flange having an interior opening forming a channel adapted to face the fuel tank, and a venting outlet coupled to the top wall at the aperture and provided to conduct fuel and fuel vapor from the interior region of the cylindrical sleeve to another destination outside the valve housing (Figure 3, element 16, 24, 30), a valve positioned to lie within the interior region of the cylindrical sleeve and formed to move within the interior region of the cylindrical sleeve to open and close the aperture defined by the top wall of the valve housing which leads to the venting outlet (Figure 3, elements 16, 30), and a tank mount made from a weldable plastics material and formed to be received within the channel of the flange of the top wall of the valve housing to cause the flange to completely surround the tank mount, the tank mount having a bottom surface adapted to be weldably coupled to the fuel tank in order to support the valve housing within a mounting aperture formed in the fuel tank (Figure 3, element 18; Column 3, lines 1-10, 21-27, 34-39).

Regarding Claim 25, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 24 above, including an apparatus wherein the tank mount forms a T-shaped cross section and the channel of the flange of the valve housing is similarly formed to define a T-shaped cross-section (Figure 2, element 18).

Regarding Claim 26, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 24 and 25 above, including an apparatus wherein the tank mount includes a horizontal portion and a vertical portion coupled to the horizontal portion at a first end and adapted to be weldably coupled to the fuel tank at a second end defining the bottom surface (Figure 3, element 18).

Regarding Claim 27, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 24 and 25 above, including an apparatus wherein the tank mount is further formed to define a notch and the flange of the valve housing includes a locator tab formed to be received within the notch of the tank mount in order to prevent rotation between the tank mount and the valve housing (Figure 1, element 40).

Regarding Claim 28, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 24 above, including an apparatus wherein the annular flange of the valve housing is formed to include a top wall coupled to the top wall of the valve housing, opposite side walls positioned to lie in spaced-apart relation to each other, and a tab portion coupled to each side wall in order to define the T-shaped channel (Figure 3, element 16).

Regarding Claim 29, Rosas shows that it is known to have a vent apparatus adapted to be coupled to a fuel tank, the apparatus comprising a valve housing made from a non-weldable plastics material and formed to include a cylindrical sleeve defining an interior region, a top wall

coupled to the cylindrical sleeve and formed to include an aperture and an annular flange having an interior opening forming a channel adapted to face the fuel tank, and a venting outlet coupled to the top wall at the aperture and provided to conduct fuel and fuel vapor from the interior region of the cylindrical sleeve to another destination outside the valve housing (Figure 3, elements 16, 24, 30), a valve positioned to lie within the interior region of the cylindrical sleeve and formed to move within the interior region of the cylindrical sleeve to open and close the aperture defined by the top wall of the valve housing which leads to the venting outlet (Figure 3, elements 16, 30), and a tank mount made from a weldable plastics material, formed to include a T-shaped portion formed to be received within the channel of the flange of the top wall of the valve housing to cause the flange to completely surround the T-shaped portion and a base portion coupled to the T-shaped portion and adapted to be weldably coupled to the fuel tank in order to support the valve housing within a mounting aperture of the fuel tank (Figure 3, element 18; Column 3, lines 1-10, 21-27, 34-39).

Regarding Claim 30, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 29 above, including an apparatus wherein the flange of the valve housing is formed to include a locator tab and the T-shaped portion of the tank mount is formed to define a notch formed to receive the locator tab therein to prevent rotation of the tank mount relative to the valve housing (Figure 1, element 40).

Regarding Claim 31, Rosas shows the apparatus as claimed as discussed in the rejection of Claim 29 above, including an apparatus wherein the T-shaped portion is formed to include a horizontal portion and a vertical portion coupled to the horizontal portion at a first end and coupled to the base portion at a second end, and the base portion is formed to include a top

surface coupled to the vertical portion, an interior surface, and exterior surface, and a bottom surface adapted to be coupled to the fuel tank (Figure 1, element 18; Figure 3, element 18).

Regarding Claim 32, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 29 and 31 above, including an apparatus wherein the flange is formed to include an outer side wall and the outer side wall is positioned to lie in coplanar relation with the exterior surface of the base portion of the tank mount (Figure 2, elements 14, 18).

Regarding Claim 33, Rosas shows the apparatus as claimed as discussed in the rejection of Claims 29 and 31 above, including an apparatus wherein the annular flange of the valve housing is formed to include a top wall coupled to the top wall of the valve housing, opposite side walls positioned to lie in spaced-apart relation to each other, and a tab portion coupled to each side wall in order to define the T-shaped channel (Figure 3, element 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde et al. (U.S. Patent 5,139,043). Regarding Claim 1, Hyde et al., hereafter "Hyde," show that it is known to carry out a method of forming a vent apparatus adapted to be coupled to a fuel tank, the method comprising the steps of providing a tank mount made of a weldable plastics material and adapted to be welded to an exterior surface of a fuel tank and injecting a non-weldable

plastics material into a valve housing mold cavity containing the tank mount to overmold the tank mount with the non-weldable plastics material to produce a valve housing having a venting outlet arranged to communicate with a valve chamber formed in the valve housing and arranged to extend above the tank mount (Column 8, lines 15-59). Although Hyde forms the non-weldable portion of the vent apparatus prior to the weldable portion, the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946).

Regarding Claim 2, Hyde shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the providing step includes the steps of forming a tank mount mold to include an tabular tank mount mold cavity having an L-shaped cross section and injecting a weldable plastics material into the annular tank mount mold cavity to produce a ling-shaped tank mount having an L-shaped cross section (Column 2, lines 5-11), meeting applicant's claim.

Regarding Claim 3, Hyde shows the process as claimed as discussed in the rejection of Claims 1 and 2 above, including a method wherein the ling-shaped tank mount includes an annular foot including a downwardly facing bottom surface adapted to be welded to an exterior surface of a fuel tank to support the valve housing in an aperture formed in the fuel tank and an annular arm coupled to the annular foot and arranged to extend radially inwardly and include an inner rib and the step of injecting a non-weldable plastics material into a valve housing mold cavity includes the steps of forming a valve housing mold to include an inner rib encapsulation portion surrounding the inner rib and filling the inner rib encapsulation portion with non-

weldable plastics material to encapsulate the inner rib to mechanically couple the valve housing to the ring-shaped tank mount (Figure 4, elements 62, 63), meeting applicant's claim.

Regarding Claim 4, Hyde shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the providing step includes the steps of forming a tank mount mold to include an annular tank mount mold cavity having specific cross section and injecting a weldable plastics material into the annular tank mount mold cavity to produce a ring-shaped tank mount having a specific cross section. Although Hyde does not exclusively show a T-shaped cross section, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the molded article when there is no evidence that the change of shape will result in new or unexpected results (*In re Dailey et al.*, 149 USPQ 47).

Regarding Claim 5, Hyde shows the process as claimed as discussed in the rejection of Claims 1 and 4 above, including a method wherein the step of injecting a non-weldable plastics material into a valve housing mold cavity includes the steps of forming a valve housing mold to include an annular tank mount encapsulation portion surrounding all but a downwardly facing bottom surface of a foot of the ring-shaped tank mount having a T-shaped cross section contained in the valve housing mold and filling the annular tank mount encapsulation portion with the non-weldable plastics material to encapsulate the ring-shaped tank mount to mechanically couple the valve housing to the ring-shaped tank mount yet expose the downwardly facing bottom surface of the foot of the ring-shaped tank mount to adapt the tank mount to be welded to an exterior surface of a fuel tank to support the valve housing in an aperture formed in the fuel tank (Figure 4, elements 62 and 63), meeting applicant's claim.

Regarding Claim 6, Hyde shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the providing step includes the steps of forming a tank mount mold to include an annular tank mount mold cavity having specific cross section and injecting a weldable plastics material into the annular tank mount mold cavity to produce a ring-shaped tank mount having a specific cross section. Although Hyde does not exclusively show a T-shaped cross section, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the molded article when there is no evidence that the change of shape will result in new or unexpected results (*In re Dailey et al.*, 149 USPQ 47).

Regarding Claim 7, Hyde shows the process as claimed as discussed in the rejection of Claims 1 and 6 above, including a method wherein the step of injecting a non-weldable plastics material into a valve housing mold cavity includes the steps of forming a valve housing mold to include an encapsulation portion surrounding an annular upper portion of the ring-shaped tank mount, the annular upper portion having a certain cross section, and a foot portion defining an annular lower portion of the ring-shaped tank mount coupled to the annular upper portion and positioned to lie below the encapsulation portion, filling the encapsulation portion with non-weldable plastics material to mechanically couple the valve housing to the ring-shaped tank mount, and filling the foot portion with non-weldable plastics material to produce the ring-shaped tank mount having a certain cross section and to provide a downwardly facing bottom surface on the annular lower portion of the ring-shaped tank mount that is adapted to be welded to an exterior surface of a fuel tank to support the valve housing in an aperture formed in the fuel tank (Figure 4, elements 62, 63).

Regarding Claim 8, Hyde shows that it is known to carry out a method of forming a vent apparatus adapted to be coupled to a vehicle fuel tank, the method comprising the steps of providing a weldable tank mount formed to include an inner rim and to define a passageway and a plastic injection mold including an upper mold portion and a lower mold portion such that the upper and lower mold portions are movable between an open position adapted to receive the weldable tank mount and a closed position adapted to retain the weldable tank mount therein (Figure 4), moving the upper and lower mold portions to the opened position, placing the weldable tank mount within one of the upper and lower mold portions of the mold cavity, moving the upper and lower mold portions to the closed position to retain the weldable tank mount within the mold cavity, filling the upper and lower mold portions with a non-weldable liquid plastics material to form a fuel systems valve component around the weldable tank mount such that the fuel systems valve component is formed to include a channel and the inner rim of the weldable tank mount is received within the channel so that the weldable tank mount is mechanically coupled to the fuel systems valve component to produce an apparatus adapted to be coupled to a fuel tank, cooling the liquid plastics material to establish a mechanical bond between the weldable tank mount and the fuel systems valve component, moving the upper and lower mold portions to the opened position, and removing the apparatus from the cavity (Column 8, lines 15-59; Figure 4). Although Hyde forms the non-weldable portion of the vent apparatus prior to the weldable portion, the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946).

Regarding Claim 9, Hyde shows the process as claimed as discussed in the rejection of Claim 8 above, including a method wherein the lower mold portion is formed to define a sleeve-forming cavity and the upper mold portion is formed to define a top wall-forming cavity and an outlet-forming cavity (Column 4, lines 8-23).

Regarding Claim 10, Hyde shows the process as claimed as discussed in the rejection of Claims 8 and 9 above, including a method wherein providing the plastic injection mold further includes the step of providing a passageway defined by the lower mold portion and formed to receive liquid plastics material so that the liquid plastics material is injected into the sleeve-forming cavity first, the top wall-forming cavity second, and the outlet-forming cavity third (Column 4, lines 8-23; Column 8, lines 15-59).

Regarding Claim 11, Hyde shows that it is known to carry out a method of forming vent apparatus adapted to be coupled to a fuel tank, the method comprising the steps of providing a tank mount formed from a weldable plastics material and formed to include a body having a certain cross-section and also providing a plastic injection mold formed to include an upper mold portion and a lower mold portion, the upper and lower mold portions being movable between an opened position adapted to receive the tank mount and a closed position adapted to retain the tank mount therein, moving the upper and lower mold portions to the opened position, placing the tank mount within one of the upper mold portion and the lower mold portion of the plastic injection mold, moving the upper and lower mold portions to the closed position to retain the tank mount within the plastic injection mold, filling the upper and lower mold portions with a non-weldable liquid plastics material to form a valve housing around the tank mount formed to define a top wall having an annular flange defining a shaped channel formed to receive the tank

mount therein to cause the tank mount to be mechanically coupled to the valve housing, cooling the liquid plastics material to establish a mechanical bond between the tank mount and the fuel systems valve component, moving the upper and lower mold portions to the opened position, and removing a unit including the valve housing and tank mount from the plastic injection mold (; Figure 4; Column 4, lines 8-23; Column 8, lines 15-59). Although Hyde forms the non-weldable portion of the vent apparatus prior to the weldable portion, the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). Furthermore, although Hyde does not exclusively show a T-shaped cross section, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the molded article when there is no evidence that the change of shape will result in new or unexpected results (*In re Dailey et al.*, 149 USPQ 47).

Regarding Claim 12, Hyde shows that it is known to carry out a method of forming a vent apparatus adapted to be coupled to a fuel tank, the method comprising the steps of providing a tank mount having a shaped cross-section and formed from a weldable plastics material and formed to include a body having a shaped upper portion and a base portion coupled to the shaped upper portion and also providing a plastic injection mold formed to include an upper mold portion and a lower mold portion wherein the upper and lower mold portions are movable between an opened position adapted to receive the tank mount and a closed position adapted to retain the tank mount therein, moving the upper and lower mold portions to the opened position, placing the tank mount within one of the upper mold portion and the lower mold portion of the plastic injection mold, moving the upper and lower mold portions to the closed position to retain

the tank mount within the plastic injection mold, filling the upper and lower mold portions with a non-weldable liquid plastics material to form a valve housing around the tank mount formed to define a top wall having an annular flange defining a shaped channel formed to receive the shaped portion of the tank mount therein to cause the tank mount to be mechanically coupled to the valve housing, cooling the liquid plastics material to establish a mechanical bond between the tank mount and the fuel systems valve component, moving the upper and lower mold portions to the opened position, and removing the valve housing and tank mount combination from the plastic injection mold (Figure 4; Column 4, lines 8-23; Column 8, lines 15-59). Although Hyde forms the non-weldable portion of the vent apparatus prior to the weldable portion, the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). Furthermore, although Hyde does not exclusively show a T-shaped cross section, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the molded article when there is no evidence that the change of shape will result in new or unexpected results (*In re Dailey et al.*, 149 USPQ 47).

Regarding Claim 34, Hyde shows that it is known to carry out a method of forming a vent apparatus adapted to be coupled to a fuel tank, the method comprising the steps of providing a tank mount formed from a weldable plastics material and formed to include a body having an shaped cross-section and also providing a plastic injection mold formed to include an upper mold portion and a lower mold portion, the upper and lower mold portions being movable between an opened position adapted to receive the tank mount and a closed position adapted to retain the tank mount therein, moving the upper and lower mold portions to the opened position, placing

the tank mount within one of the upper mold portion and the lower mold portion of the plastic injection mold, moving the upper and lower mold portions to the closed position to retain the tank mount within the plastic injection mold, filling the upper and lower mold portions with a non-weldable liquid plastics material to form a valve housing around the tank mount formed to define a top wall having an annular flange defining an shaped channel formed to receive the tank mount therein to cause the tank mount to be mechanically coupled to the valve housing, cooling the liquid plastics material to establish a mechanical bond between the tank mount and the fuel systems valve component, moving the upper and lower mold portions to the opened position, and removing a unit including the valve housing and tank mount from the plastic injection mold (Figure 4; Column 4, lines 8-23; Column 8, lines 15-59). Although Hyde forms the non-weldable portion of the vent apparatus prior to the weldable portion, the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). Furthermore, although Hyde does not exclusively show a T-shaped cross section, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to change the shape of the molded article when there is no evidence that the change of shape will result in new or unexpected results (*In re Dailey et al.*, 149 USPQ 47).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 8-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-8 of prior U.S. Patent No. 6,488,877. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,488,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application's claims contain the same basic subject matter but are merely more brief than those of the '877 patent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to the manufacture of tank vent apparatuses:

U.S. Patent 4,323,529 to Roberts et al.

U.S. Patent 6,003,499 to Devall et al.

U.S. Patent 6,189,567 to Foltz

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maf
February 6, 2004

MICHAEL COLAIANNI
PRIMARY EXAMINER